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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,636	12/01/2003	Michael Jonas Borg	10006802-5	4536

7590

05/25/2004

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P. O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER
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VO, HIEN XUAN

ART UNIT	PAPER NUMBER
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2863

DATE MAILED: 05/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application N 10/725,636	Applicant(s) BORG, MICHAEL JONAS	
	Examiner Hien Vo	Art Unit 2863	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2001.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Notice to Applicant(s)***

1. This application has been examined. Claims 1-24 are pending.

***Claim Rejections - 35 USC 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-8, and 15-22 are rejected under 35 U.S.C. **102(b)** as being anticipated by Budnik et al. (U.S. Patent No.6,016,204).

4. With respect to claim 1, Budnik et al. disclose the actuator performance indicator including the step of performing initial calibration procedure to produce a first performance metric (see e.g. Figs. 5A-10 and col.14, lines 55-62), performing a subsequence calibration procedure to produce a second performance metric (see e.g. col.14, lines 63-68), comparing the second performance metric with the first performance metric (see e.g. col.20, lines 49-50), and outputting a performance factor indicative of a change in performance resulting from a change in the user serviceable components (see e.g. col. 10, lines 53-56).

With respect to claims 2-3, Budnik et al. disclose the invention as claimed including the step of sending a notification that the performance factor has crossed a predetermined threshold (see e.g. col. 15, lines 30-37), and disabling the apparatus if the performance factor has a crossed a predetermined threshold (see e.g. Fig.10, step 270, 272).

With respect to claims 4-6, Budnik et al. disclose the invention as claimed including the initial calibration procedure is performed at the time of manufacture of the apparatus and the time a user serviceable component is replaced (see e.g. Fig.12 and col. 17, lines 4-57).

With respect to claims 7-8, Budnik et al. disclose the invention as claimed including the step of communication the performance factor to a service provider via Internet (see e.g. Figs. 13-14).

Claims 15-21 are apparatus claims corresponding to method claims 1-8. Therefore, claims 15-21 are rejected for the same rationales set forth for claims 1-8.

With respect to claim 22, Budnik et al. disclose the invention as claimed including the apparatus is a printer (see e.g. col. 1, line 4).

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1, 9-15, 23-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5-8 of U.S. Patent No. 6,687,634.

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U.S. Patent No. 6,687,634

<p>1. A method for monitoring the performance of an apparatus having user serviceable components, comprising the steps of: performing initial calibration procedure to produce a first performance metric; performing a subsequent calibration procedure to produce a second performance metric; comparing said second performance metric with said first performance metric, and outputting a performance factor indicative of a change in performance resulting from a change in the user serviceable components.</p>	<p>1. A method for monitoring the performance of an apparatus comprising the steps of: performing initial calibration procedure to produce a first performance metric; <u>detecting the presence of a third party user serviceable component by identifying the absence of a predetermined electronic label</u>; performing a subsequent calibration procedure to produce a second performance metric; comparing said second performance metric with said first performance metric, and outputting a performance factor indicative of a change in performance resulting from the use of <u>said third party user serviceable component</u>.</p>
<p>9. A method for monitoring the performance of an apparatus comprising the steps of: performing initial calibration procedure to produce a first performance metric; detecting the presence of a third party user serviceable component by identifying the absence of a predetermined electronic label; performing subsequent calibration procedure to produce a second performance metric; comparing said second performance metric with said first performance metric, and outputting a performance factor indicative of a change in performance resulting from the use of said third party user serviceable component.</p>	<p>1. A method for monitoring the performance of an apparatus comprising the steps of: performing initial calibration procedure to produce a first performance metric; detecting the presence of a third party user serviceable component by identifying the absence of a predetermined electronic label; performing a subsequent calibration procedure to produce a second performance metric; comparing said second performance metric with said first performance metric, and outputting a performance factor indicative of a change in performance resulting from the use of said third party user serviceable component.</p>

<p>10. A method of identifying the presence of third party replacement consumables in an apparatus the method comprising the steps of: reading first information indicative to an amount of consumption of a consumables from an electronic label for an originally installed user serviceable component; storing said first information; subsequently repeating said reading step to produce second information indicative of an amount for consumption, and comparing said second information with said first information thereby identifying an increase in the amount of the consumable; outputting a replacement indicator indicative of an increase in the quantity of said consumable.</p>	<p>2. A method of identifying the presence of third party replacement consumables in an apparatus the method comprising the steps of: reading first information indicative to an amount of consumption of a consumable from an electronic label for an originally installed user serviceable component; storing said first information; subsequently repeating said reading step to produce second information indicative of an amount for consumption, and comparing said second information with said first information thereby identifying an increase in the amount of the consumable; outputting a replacement indicator indicative of an increase in the quantity of said consumable.</p>
<p>11. A method of identifying invalid service claims for an apparatus having user serviceable components, comprising the steps of: performing initial calibration procedure to produce a first performance metric; performing a subsequent calibration procedure to produce a second performance metric; comparing said second performance metric with said first performance metric; outputting a performance factor indicative of a reduction in performance resulting from a change in the user serviceable components with a third party user serviceable component, and determining the validity of a subsequent service claim according to said performance factor.</p>	<p>3. A method of identifying invalid service claims for an apparatus having user serviceable components, comprising the steps of: performing initial calibration procedure to produce a first performance metric; performing a subsequent calibration procedure to produce a second performance metric; comparing said second performance metric with said first performance metric; outputting a performance factor indicative of a reduction in performance resulting from a change in the user serviceable components with a third party user serviceable component, and determining the validity of a subsequent service claim according to said performance factor.</p>
<p>12. The method of Claim 11 further comprising the step of establishing the cost of providing service for the apparatus according to said determined validity of the service claim.</p> <p>13. A method of identifying invalid service claims for an apparatus, wherein certain originally installed user serviceable components include an electronic label, the method comprising the steps of: performing initial calibration procedure to produce a first performance metric; detecting the presence of a third party user serviceable component by identifying the absence of a proper electronic label; performing a subsequent calibration procedure to produce a second performance metric; comparing said second performance metric with said first performance metric; outputting a performance factor indicative of a change in performance resulting from the use of said third party user serviceable component; and determining the validity of a subsequent service claim according to said performance factor.</p>	<p>4. The method of claim 3 further comprising the step of establishing the cost of providing service for the apparatus according to said determined validity of the service claim.</p> <p>5. A method of identifying invalid service claims for an apparatus, wherein certain originally installed user serviceable components include an electronic label, the method comprising the steps of: performing initial calibration procedure to produce a first performance metric; detecting the presence of a third party user serviceable component by identifying the absence of a proper electronic label; performing a subsequent calibration procedure to produce a second performance metric; comparing said second performance metric with said first performance metric; outputting a performance factor indicative of a change in performance resulting from the use of said third party user serviceable component; and determining the validity of a subsequent service claim according to said performance factor.</p>

14. The method of Claim 13 further comprising the step of establishing the cost of providing service for the apparatus according to said determined validity of the service claim.

15. An apparatus having user serviceable components enabled to monitor its own performance, the apparatus comprising:  
means for performing an initial calibration procedure to produce a first performance metric;  
means for performing a subsequent calibration procedure to produce a second performance metric;  
means for comparing said second performance metric with said first performance metric; and  
means for outputting a performance factor indicative of a change in performance resulting from a change in the user serviceable components.

23. An apparatus having user serviceable components, the apparatus being operable to monitor its own performance and comprising:  
means for performing initial calibration procedure to produce a first performance metric;  
means for detecting the presence of a third party user serviceable component by identifying the absence of a predetermined electronic label;  
means for performing a subsequent calibration procedure to produce a second performance metric;  
means for comparing said second performance metric with said first performance metric; and  
means for outputting a performance factor indicative of a change in performance resulting from the use of said third party user serviceable component.

24. An apparatus having user serviceable components, certain of which have electronic labels, and having consumables in the user serviceable components, the apparatus, comprising:  
means for reading first information indicative of an amount of consumption of a consumable from an electronic label for at least one originally installed user serviceable components;  
a memory for storing said first information;  
means for subsequently reading second information indicative of an amount for consumption of said consumable from said electronic label;  
means for comparing said second information with said first information thereby identifying an increase in the amount of the consumable; and  
means for outputting a replacement factor indicative of an increase in the quantity of said consumable.

6. The method of claim 5 further comprising the step of establishing the cost of providing service for the apparatus according to said determined validity of the service claim.

7. An apparatus having user serviceable components, the apparatus being operable to monitor its own performance and comprising:  
means for performing initial calibration procedure to produce a first performance metric;  
means for detecting the presence of a third party user serviceable component by identifying the absence of a predetermined electronic label;  
means for performing a subsequent calibration procedure to produce a second performance metric;  
means for comparing said second performance metric with said first performance metric; and  
means for outputting a performance factor indicative of a change in performance resulting from the use of said third party user serviceable component.

7. An apparatus having user serviceable components, the apparatus being operable to monitor its own performance and comprising:  
means for performing initial calibration procedure to produce a first performance metric;  
means for detecting the presence of a third party user serviceable component by identifying the absence of a predetermined electronic label;  
means for performing a subsequent calibration procedure to produce a second performance metric;  
means for comparing said second performance metric with said first performance metric; and  
means for outputting a performance factor indicative of a change in performance resulting from the use of said third party user serviceable component.

8. An apparatus having user serviceable components, certain of which have electronic labels, and having consumables in the user serviceable components, the apparatus, comprising:  
means for reading first information indicative of an amount of consumption of a consumable from an electronic label for at least one originally installed user serviceable components;  
a memory for storing said first information;  
means for subsequently reading second information indicative of an amount for consumption of said consumable from said electronic label;  
means for comparing said second information with said first information thereby identifying an increase in the amount of the consumable; and  
means for outputting a replacement factor indicative of an increase in the quantity of said consumable.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the independent claims of the present application differ from the patented claims in having the phrase: "detecting the presence of a third party user serviceable component by identifying the absence of a predetermined electronic label" or the equivalent language. In order to monitoring the performance of an apparatus , applicant must base on a calibration procedure, performing the analytic tests on the third party part, and particularly to the model and analysis of the system resources. Therefore, the subject claims are broader than the Patent claims. It would therefore have been obvious to modify the claims of U.S. Patent No. 6,687,634 to claim the more limited " detecting the presence of a third party user serviceable component by identifying the absence of a predetermined electronic label ".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hien X. Vo whose telephone number is (571) 272-2282. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached on (571) 272-2269. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

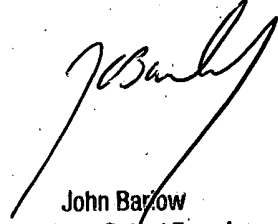


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**HIEN VO**  
May 17, 2004



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